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EXAMINER
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DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/692,402

**Applicant(s)**

TRACY ET AL.

**Examiner**

Thomas A. Dixon

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-28, 30-35 and 37-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-22, 29 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-28, 30-35, 37, 38 and 40-44 is/are rejected.
- 7) ☒ Claim(s) 39 and 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 23-28, 30-35, 37-45 are pending in the application, claims 1-22, 29 and 36 have been cancelled.
2. A careful reading of the claims, an updated search and review of the references necessitated the rejections below.

#### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 8/11/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 5,979,757 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Objections***

4. The objections of the previous action are withdrawn in view of applicant's amendments.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 23-24, 31-35, 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.
6. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to

Art Unit: 3629

"[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

7. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

8. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

Art Unit: 3629

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

9. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

10. In the present application, Claim 23, and the named dependents claim email, there is no manipulation of the data, simply moving it from one location to another. In this case the claims, as written, are broad enough to encompass a person emailing a shopping list to himself (or one spouse emailing to the other spouse) and picking up the email at a kiosk at a shopping facility, which could be seen as a 102 using the PC EXPO reference or the Straits Times reference of checking email at a kiosk.

### ***Claim Interpretation***

Art Unit: 3629

11. Claims directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of claim 30, including a a kiosk, see figure 2 (220A,B,C), a self-scanning system, a plurality of checkout lanes, a communications device are disclosed in Roach et al (5,310,997) as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Thus the structural limitations of claim 40, including a communication system, a kiosk, a self-scanning system and a plurality of checkout lanes are disclosed in Roach et al (5,310,997) as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Thus the structural limitations of claim 43, including a means for generating, means for transmitting, means for storing, means for retrieving and means for communicating and further a scanner are disclosed in Bianco (5,047,614) as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 30, 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Roach et al (5,310,997).

As per Claim 30.

Roach et al ('997) discloses:

a kiosk, see figure 2 (220A,B,C)

a self-scanning system see (18);

a plurality of checkout lanes, see (18, 16)

Art Unit: 3629

a communications device, see figure 2 (32,34,RF).

As per Claim 40.

Roach et al ('997) discloses:

a communications system, see figure 2 (32, 34, RF);

a kiosk (220A,B,C)

a self-scanning system see (18);

a plurality of checkout lanes, see (18, 16).

As per Claim 41,42.

The limitations of the claim do not distinguish the claimed apparatus from the prior art.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 23-24, 27-28, 35-36, 38, 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco (6,047,614) in view of PC EXPO.

As per Claim 23.

Bianco ('614) discloses:

- a) generating a list of desired items at a location remote from the shopping facility, see column 3, lines 14-43;
- b) transmitting the list to a first computer, see column 3, lines 44-52;
- c) storing the list in a user data file on the first computer, see column 3, lines 33-35 and column 3, lines 57-52 and column 4, lines 49-67;
- d) retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer, see column 3, lines 44-50;
- e) delivering the list to the user at the shopping facility in a user perceptible format, see column 3, lines 52-57.

Bianco further discloses transmitting a list via modem, see column 4, lines 26-35 but does not disclose use of email for communication.

PC EXPO teaches that email is old and well known and the receiving of email at a kiosk is old and well known for the benefit of using a well known form of electronic communication.

Art Unit: 3629

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email as taught by PC EXPO in the invention of Bianco for the benefit of using a well known form of electronic communication.

As per Claim 24.

Bianco ('614) further discloses first computer is a user computer and the list is communicated through electronic communications means, see column 3, lines 14-57 and column 4, lines 26-40.

As per Claim 27.

Bianco ('614) further discloses marketing messages, see column 4, lines 1-8.

As per Claim 28.

Bianco ('614) further discloses marketing messages are selected from the group comprising a discount coupon and competitive product availability, see column 4, lines 1-8.

As per Claim 35.

Bianco ('614) further discloses creating a list from previously purchased items, see column 3, lines 29-34.

As per Claim 35.

Bianco ('614) further discloses the format is one of text data, audio data, see column 3, lines 52-57 and column 4, lines 30-35.

As per Claim 38.

Bianco ('614) discloses:

- a) generating a list of desired items at a home computing device, see column 3, lines 14-43;
- b) transmitting the list to a store computer, see column 3, lines 44-52 and column 4, lines 26-30;
- c) storing the list in a user data file on the first computer, see column 3, lines 33-35 and column 3, lines 57-52 and column 4, lines 49-67;
- d) retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer, see column 3, lines 44-50;
- e) delivering the list to the user at the shopping facility in a user perceptible format, see column 3, lines 52-57.

Bianco further discloses transmitting a list via modem, see column 4, lines 26-35 but does not disclose use of email for communication.

PC EXPO teaches that email is old and well known and the receiving of email at a kiosk is old and well known for the benefit of using a well known form of electronic communication.



Art Unit: 3629

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email as taught by PC EXPO in the invention of Bianco for the benefit of using a well known form of electronic communication.

As per Claim 43.

Bianco ('614) discloses:

means for generating a list of desired items at a location remote from the shopping facility, see column 3, lines 14-43;

means for transmitting the list to a first computer, see column 3, lines 44-52;

means for storing the list in a user data file on the first computer, see column 3, lines 33-35 and column 3, lines 57-52 and column 4, lines 49-67;

means for retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer, see column 3, lines 44-50;

means for communicating the list to the user at the shopping facility in a user perceptible format, see column 3, lines 52-57.

Bianco further discloses transmitting a list via modem, see column 4, lines 26-35 but does not disclose use of email for communication.

PC EXPO teaches that email is old and well known and the receiving of email at a kiosk is old and well known for the benefit of using a well known form of electronic communication.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email as taught by PC EXPO in the invention of Bianco for the benefit of using a well known form of electronic communication.

As per Claim 44.

Bianco ('614) further discloses a portable shopping terminal capable of scanning items, see column 3, lines 29-34.

14. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco (6,047,614) in view of PC EXPO further in view of Roach et al (6,310,977).

As per Claim 25.

Bianco ('614) further discloses giving advice to shoppers, see column 4, lines 1-8 and 59-67 and a link to the store's inventory system, see column 3, lines 47-52, but does not disclose delivering a message regarding items which are out of stock.

Roach et al ('977) teaches checking for stock and offering comparable items if out of stock, see figure 3a (330, 332) for the benefit of making a sale even though the item of interest is out of stock.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to give a message identifying items out of stock and giving alternatives as taught by Roach et al ('977) for the benefit of making a sale even though the item of interest is out of stock.

Art Unit: 3629

As per Claim 26.

Bianco ('614) further discloses identifying alternate products, see column 4, lines 64-67.

15. Claims 31-33, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco (6,047,614) in view of PC EXPO further in view of Gordon (5,608,786).

As per Claim 31.

Bianco ('614) further discloses preference information from the user, see column 4, lines 49-62, but does not disclose automatically associating the user data file with a predetermined email address such that the email is delivered via the e-mail address.

Gordon teaches a system which associates email to a specific user data file, see column 3, lines 36-41 for the benefit of allowing the user to always be contacted.

Therefore, it would have been obvious to one of ordinary skill in the art, at the with the data file time the invention was made to automatically associate a predetermined email address with a user file for the benefit of allowing the user to always be contacted.

As per Claim 32.

Bianco ('614) does not disclose indicating to the user that the email is present.

Official Notice is taken that it is old and well known in the computer arts to inform computer users that they have mail, for example, Microsoft's Email provides a popup box to say you have mail, and America Online had a verbal "You've Got Mail" indicator for the benefit of alerting computer user's to their mail.

Gordon teaches a system which alerts users to email received, see column 3, lines 36-41 for the benefit of allowing the user to always be contacted.

Therefore, it would have been obvious to one of ordinary skill in the art, at the with the data file time the invention was made to automatically alert a user of email for the benefit of allowing the user to always be contacted.

As per Claim 33.

Bianco ('614) does not disclose indicating to the user that the email is present at the portable terminal assigned to the user at the shopping facility.

Official Notice is taken that it is old and well known in the computer arts to inform computer users that they have mail, for example, Microsoft's Email provides a popup box to say you have mail, and America Online had a verbal "You've Got Mail" indicator for the benefit of alerting computer user's to their mail.

Gordon teaches a system which alerts users to email received a portable device, see column 3, lines 36-41 for the benefit of allowing the user to always be contacted.

Therefore, it would have been obvious to one of ordinary skill in the art, at the with the data file time the invention was made to automatically alert a user of email for the benefit of allowing the user to always be contacted.

Art Unit: 3629

As per Claim 34.

Bianco ('614) does not disclose the user selects an option of the portable terminal to display email.

Gordon teaches a user selects an option to display email on a portable terminal, see column 3, lines 36-41 for the benefit of allowing the user to always be contacted.

Therefore, it would have been obvious to one of ordinary skill in the art, at the with the data file time the invention was made to automatically alert a user of email for the benefit of allowing the user to always be contacted.

***Allowable Subject Matter***

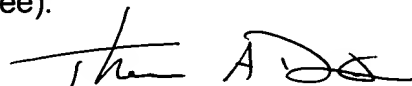
16. Claims 39, 45 are objected to as being based on a rejected base claim, but would be allowable if written in independent form.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Thomas A. Dixon', with a stylized flourish at the end.

Thomas A. Dixon  
Primary Examiner  
Art Unit 3629

February 05